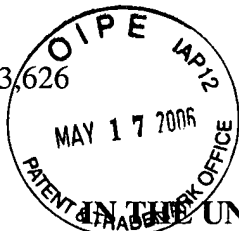


09/823,626



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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

David K. BRAVERMAN

Application No.: 09/823,626

Group Art Unit: 2161

Filed: March 30, 2001

Examiner: Leroux, Etienne Pierre

Attorney Docket: COS99036

Customer No.: 25537

Client Docket: 09710-1067

For: ACCOUNT MANAGEMENT TOOL FOR E-BILLING SYSTEM

REPLY BRIEF

Honorable Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is submitted, in triplicate, in response to the Examiner's Answer mailed
March 14, 2006.

**I. THE EXAMINER'S ANSWER IS PREMISED ON INCONSISTENTLY
CONSTRUING THE CLAIM TERM "DETECTING AN EVENT."**

The Examiner's Answer violates a basic rule of claim construction set down in *Process
Control Group v. HydReclaim Corp.*, 190 F.3d 1350, 1356 (Fed. Cir. 1999):

It is clear from the language of the claim itself that the term "a discharge rate" in clause [b] is referring to the same rate as the term "the discharge rate" in clause [d]. This conclusion necessarily results from the identical language associated with the term "discharge rate" in both clauses [b] and [d], namely "from the common hopper to the material processing machine." The presence of that identical language clearly indicates that "a discharge rate" in clause [b] is the

same as “the discharge rate” in clause [d], both referring to the rate (in units of weight per unit of time) that material is discharged from the common hopper to the material processing machine. In addition, that conclusion avoids any lack of antecedent basis problem for the occurrence of “the discharge rate” in clause [d].

In the present case, the Examiner adopts one construction for “detecting an event” but later switches to a different interpretation for the same claim language later in the claim, “in response to detecting the event,” differing only in antecedent basis. For example, claim 1 recites the following (with clauses labeled in brackets and emphasis added):

1. (Previously Presented) A method for providing an on-line billing system, the method comprising:

- [a] storing account information of a plurality of customers in a database, the account information including information for associating each of the plurality of customers with a particular agent among a plurality of agents;
- [b] generating a list of customer accounts corresponding to the particular agent from the account information;
- [c] displaying the list via a web browser to the particular agent;
- [d] **detecting an event** that changes an association between one of the customers and the particular agent;
- [e] determining whether the particular agent has enabled notification of account changes; and
- [f] in response to **detecting the event** and determining that the particular agent has enabled notification of account changes, generating an electronic mail message describing the event and sending the electronic mail message to the particular agent.

For “detecting an event” in clause [d], the Examiner construed it to read on the receipt of an electronic account application from a merchant in an online paperless account approval and provisioning technique described in *Woloshin et al.* (US 2002/0026410): “Woloshin discloses detecting an event that changes an association between one of the customers and the particular agent [Woloshin: event is receipt of application, paragraph 20]” (Examiner’s Answer, p. 5). Yet, after admitting that both *Tabb et al.* (5,787,416) and *Woloshin et al.* lack disclosure of the material for clause [f] of the claim, the Examiner contended that this element is nonetheless found in *Gifford et al.*, citing FIG. 5 and paragraphs 155-156 (Examiner’s Answer, pp. 6 and 10-

11). However, neither these paragraphs nor anywhere in *Gifford et al.* relate to the receipt of an application, as the Examiner previously construed the term “detecting an event.” Rather, the steps cited by the Examiner are in response to the event that a “caller leaves a voicemail or fax message” (FIG. 5, step 500).

The Examiner’s rejection of the claims cannot be salvaged by adopting one of the inconsistent interpretations for both clauses [d] and [f]. On the one hand, the *Gifford et al.* construction of the “event” as the receipt of voicemail or facsimile for clause [d] is inappropriate, because the mere receipt of a voicemail or a fax does not meet the additional claim limitation of that it “changes an association between one of the customers and the particular agent.”

On the other hand, the *Woloshin et al.* construction of “detecting an event” as the receipt of a merchant’s online enrollment form does not fit the Examiner’s reading of clause [f], because *Gifford et al.*’s selective email notification feature in FIG. 5 pertains only to converting incoming voicemail, faxes, or other non-literal messages. In *Woloshin et al.*, however, the initial application is on-line and the notification approval is by an automatically sent electronic mail message (¶ 20). Thus, applying the *Gifford et al.* voice mail and fax feature to *Woloshin et al.* means that *Woloshin et al.*’s principle of operation would have to be changed to use voicemail notifications instead, a modification taught against by *Woloshin et al.*’s desire for “an integrated, paperless, and fully automated online system” (¶ 6).

Moreover, *Woloshin et al.*’s automatically sending out an email when a merchant is enrolled exposes another problem in the Examiner’s rejection—its lack of motivation. The Examiner proposed a modification of *Tabb et al.* and *Woloshin et al.* using *Gifford et al.* “for the purpose [of] providing the sales representative with an update regarding his/her customer list”

(Examiner's Answer, p. 6).¹ Yet *Woloshin et al.* already has an email be sent when a merchant is enrolled (§ 20). This feature means that the Examiner's proposed modification of using *Gifford et al.* has no expected advantage and that there is no motivation to modify *Woloshin et al.* to do what is already done.

The Examiner's adoption of at least two and possibly three different claim constructions to "detecting the event," each corresponding to a separate reference, is symptomatic of a larger problem in the rejection—impermissible hindsight. The rejection cobbles together a disparate set of features from three separate references, using the claims as a roadmap because one of ordinary in the art lacks the motivation to do what the Examiner proposes. That different interpretations of "detecting an event" are necessary to piece together the rejection underscores the non-obviousness of the Appellant's claims.

II. CONCLUSION

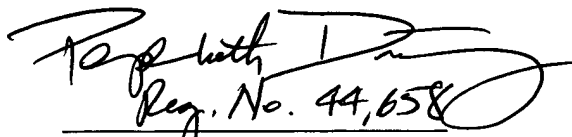
Appellant, therefore, requests the Honorable Board to reverse the Examiner's rejection.

Respectfully Submitted,

DITTHAVONG & MORI, P.C.

5/15/06

Date

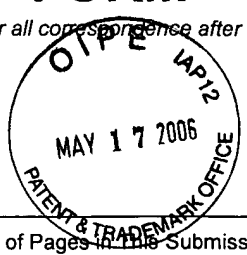


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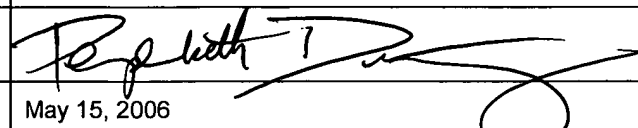
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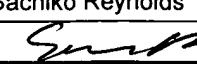
¹ The Examiner's statement of the proposed modification gives a possible *third* construction for detecting this event, this time "updates to the customer list," citing *Tabb et al.*, col. 17:53-57. However, that portion of *Tabb et al.* only describes the structure of a customer list.

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		Filing Date	March 30, 2001
		In re Application of:	David K. BRAVERMAN
		Group Art Unit	2161
		Examiner Name	Leroux, Etienne Pierre
		Attorney Docket Number	COS99036
Total Number of Pages in This Submission	5	Customer Number	25537

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	DITTHAVONG & MORI, P.C. Phouphanomketh Ditthavong, Reg. No. 44658
Signature	
Date	May 15, 2006

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